

PTOL-303 CONTINUATION SHEET

The amendment filed 3/14/2008 under 37 CFR 1.116 in reply to the final rejection has NOT been entered. The final Office action, mailed 11/20/2007, is maintained.

The proposed amendment to claim 103 ~~does not obviously place the claim in condition for allowance and raises new issues that would require further search and consideration.~~ In the prior action, it was indicated that the mutated residues disclosed in the present specification for *E. coli* valyl tRNA synthetase are conserved in the valyl-tRNA synthetases of *Saccharomyces cerevisiae* and other bacteria, and that one would expect that the same mutations in *Saccharomyces cerevisiae* and other bacteria could provide the structure necessary for the valyl-tRNA synthetases of to charge a tRNA^{Val} with cysteine (pages 8-9 of the Office action mailed 11/20/2007). However, the proposed amendment to claim 103 encompasses all yeast cells and is not limited to *Saccharomyces cerevisiae*. Further, the claim is drawn to mutations "corresponding to K277Q, R223H, V276A or D230N, which allows said valyl-tRNA synthase to charge compounds that show steric resemblance to valine." Thus, the claims encompass more than charging of a tRNA^{Val} with cysteine. The additional compounds encompassed by the claim, as well as the nature of the correspondence of the mutation to specific mutations in homologous sequences, require further consideration. Accordingly, the amendment of claim 103 to delete a large amount of the text and add the new wherein clause significantly alters the scope of the claim such that further search and consideration are required.

The proposed addition of new claims 119-132 raises new issues. The claims contain limitations that were not previously considered. Accordingly, the addition of new claims 119-132 would require further search and consideration.

Comment [D1]: I noticed in your interview summary that you state, "The Examiner indicated that an after final amendment containing new or amended claims that did not obviously place the case in condition for allowance would not be entered." Remind me that an amendment that simplifies issues for appeal (e.g., overcomes some 112, second, rejections) should be entered, as long as it does not raise any new issues, even if it does not obviously place the case in condition for allowance. I think what you have here is OK but I would soften the statement in the interview summary.

With regard to Applicant's arguments directed to the rejections under 35 U.S.C. 112, all arguments are directed to the newly amended claims. As discussed above, the amendments have not been entered. Therefore, the arguments are moot and will not be addressed. No arguments directed to the pending claims have been presented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Dunston whose telephone number is 571-272-2916. The examiner can normally be reached on M-F, 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached at 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Jennifer Dunston, Ph.D.
Examiner
Art Unit 1636

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